

Remarks

Applicants request entry of the above amendments canceling Claims 1, 3-6, 13-22, 28 and 30-32 if doing so will place the case in condition for allowance.

Claim Objections

Claim 7 is being amended to recite "said" printer at line 10. Recitation of "a" printer in Claim 7 at line 7 appears to be appropriate.

Claims 7, 33, 40 and 42 -- Switching Modes

Claim 33 recites programming that causes the printer to switch from a first mode of operation (responding to a printer server) to a second mode of operation (responding only to a printer driver residing on a computer different from the printer server) when a print job assurance feature is selected, in addition to comparing first and second values for a printer resource. The combination of Owa (6348971) and Watanabe (6185010) does not teach or suggest all of these claim limitations and, in any event, the combination is not properly motivated.

Owa teaches a host computer, a group of printers and a server all connected to the same network. Owa does not teach any kind of a control signal generated by any kind of a controller that causes one of the printers to switch between modes or any mode in which the printer responds only to a printer driver that is not on the server. The most that can be said about the network in Owa is that a printer might be responsive to the server and the host computer. Any such responsiveness, however, does not necessarily imply or even suggest switching from one mode of operation to another or switching to a mode of operation in which the printer is not responsive to the server. Watanabe teaches a multi-function printing device with selection keys for designating the fax mode, the local printer mode and the network printer mode.

Neither Owa nor Watanabe teaches or even suggests switching modes when a print assurance feature is selected as in Claim 33. More specifically, neither reference teaches or suggests causing the printer to switch from a first mode of operation (responding to a printer server) to a second mode of operation (responding only to a printer driver residing on a computer different from the printer server) when a print job assurance feature is selected. The Office does not specifically address the print assurance condition limitation in Claim 33. The Office has, therefore, failed to establish a prima facie case of obviousness with regard to

Claim 33. In fact, the combination of Owa and Watanabe does not teach or suggest all of the limitations of Claim 33. The rejection of Claim 33 should be withdrawn.

Claims 7, 40 and 42 contain limitations similar to Claim 33, except that switching is not conditioned on selecting a print assurance feature. Claim 7, for example, recites a comparator configured to generate an output signal based on the comparison printer resource needed and printer resource available values and a controller configured to control the comparator, to generate a first control signal based on the comparator output signal and to generate a second control signal for causing the printer to switch between a first mode of operation (responding to a printer server) to a second mode of operation (responding only to a printer driver residing on a computer different from the printer server).

Assuming without conceding that Watanabe might reasonably be construed to teach switching modes as in Claims 7, 40 and 42, there is still no motivation to combine this teaching with Owa. Obviousness can only be established by combining the teachings of two references where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Office must rely on objective evidence and make specific factual findings with respect to the motivation to combine references. MPEP § 2143.01; See, e.g., *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

The Office asserts the combination is motivated "to provide a user with an option of deciding the mode of the printer using a user interface display." Office Action, page 13. The asserted motivation is irrelevant to the Owa/Watanabe combination. Owa is directed (in relevant part) to evaluating printer resources. Watanabe is directed (in relevant part) to a user selecting the mode of operation of a multi-function printing device. It is axiomatic, of course, that Watanabe provides a user with an option of deciding the mode of the printer using a user interface display. After all, you cannot allow the user to select the mode of operation without providing some sort of selection mechanism. This teaching, however, suggests nothing about combining any such feature with the evaluation system of Owa (or any other print controller feature). The Office is obligated to show something that motivates the combination – simply restating the teaching of Watanabe is not sufficient. If the Office disagrees, it is respectfully requested to explain how Watanabe's "option of

deciding the mode of the printer using a ... display" motivates any sort of combination with Owa's printer resource evaluation system, and to provide the required objective evidence and specific factual findings supporting the explanation. Absent such a showing, the rejections should be withdrawn.

The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,



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